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EXAMINER
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ART UNIT	PAPER NUMBER
2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/729,813	SRIVASTAVA, BIPLAV
	Examiner	Art Unit	
	Sathyanarayan Pannala	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 February 2009</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>16,17,30 and 31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>16,17,30 and 31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's Amendment filed on 2/19/2009 has been entered with amended

claims 16, 30-31. In this Office Action, claims 16-17 and 30-31 are pending.

Claim Objections

2.   Applicant's amendment overcomes the objection of Claims 16 and 17 and the

objection is withdrawn.

3.   Claim 16 and 30 are objected because of minor error is "if-the-else-rules" instead

of "if-then-else rules". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claims 16 and 30 are rejected under 35 U.S.C. 112, second paragraph, as they

recites the indefinite limitation phrase as "to be" in claim 16, line 4. Because the phrase

is unclear whether performed or not and similarly used in claim 30. Appropriate

correction is required.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 16-17 and 30-31 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Zambo et al. (US Patent 6,985,907) hereinafter Zambo, in view of

McCollum et al. (USPA Pub. 2005/0091640 A1) hereinafter McCollum, in view of Bigus

et al. (US Patent 7,136,843) hereinafter Bigus, and further in view of Applicant Admitted

Prior Art (AAPA).

selecting a rules system by a computer such that codes are represented in a form

corresponding to a particular type of analysis to be performed on said codes, wherein

said rules system includes one of fuzzy rules, if-then-else-rules and declarative rules,

and wherein said codes comprise natural language text of one of laws, policy statement,

contract provisions, agreements, regulations, rules of association, constitutions, and

codes of conduct

8.   As per independent claims 16 and 30, Zambo teaches a method of codifying field

claims with the most severe of the applicable condition codes (col. 2, lines 17-19).

Zambo teaches the claimed, an automated computer implemented method for

identifying applicable provisions in codes (col. 2, lines 19-21, the codes are applied

based on severity ranking of plurality of condition of codes which is the came concept

as the current invention the codes are identified based on provision codes). Zambo

teaches the claimed, selecting a rules system by a computer such that codes are

represented in a form corresponding to a particular type of analysis to be performed on

said codes (Table 2, col. 6, lines 65-67).

Zambo teaches the claimed, mapping said codes to target rules representing

said codes based on said selected rules system to target rules using grammar and

syntax (Fig. 2, col.4, lines 45-61 and table 2, col. 6, lines 65-67).

Zambo does not explicitly teach rules. However, McCollum teaches the claimed,

identifying applicable provisions of said codes based on said first and second

evaluations, wherein said applicable codes match said evaluation functions as applied

to said target rules (page 1, paragraph [0003]). McCollum also teaches the claimed,

populating a template of generated target rules with data from said codes based on said

selected rules system (Fig. 6, page 23, paragraph [0277]).

Zambo does not explicitly teach applying evaluation function to said rules.

However, McCollum also teaches the claimed, applying evaluation functions to said

target rules that represent said codes, to identify applicable provisions of said codes,

wherein a first evaluation function comprises one user's perspective of said codes, and

wherein a second evaluation function comprises a trigger event relating to said codes

(Fig. 3, page 14, paragraph [0236]). Thus, it would have been obvious to one of

ordinary skill in the data processing art at the time of the invention, to have combined

the teachings of the cited references because McCollum's teachings would have allowed Zambo's method to execute plurality of rules simultaneously instead of executing sequentially in order to use computer resources more efficiently (page 1, paragraph [0003]).

Zambo and McCollum do not explicitly teach rule system including one of fuzzy rules and other listed rules. However, Bigus teaches the claimed, a rule system, said rule system including one of fuzzy rules, if-the-else-rules, and declarative rules (col. 4, line 64 to col. 5, line 2; col. 4, lines 30-33 and col. 5, lines 15-26). Bigus also teaches outputting said applicable provisions o said codes by said computer (Fig. 6, col. 8, lines 5-6). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Bigus' teachings would have allowed Zambo's method for initialization or setup code is required to intermix with the processing and evaluation of declarative rules-based knowledge (col. 1, lines 64-67).

Zambo, McCollum and Bigus do not explicitly teach types of codes. AAPA teaches the claimed, codes comprise natural language text of one of laws, policy statements, contract provisions, agreements, regulations, rules of association, constitutions, and codes of conduct (page 1, paragraph [0002]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because AAPA's teachings would have allowed Zambo's method to improve using codes (page 1,

paragraph [0005]).

9.   As per dependent claims 17 and 31, Zambo teaches the claimed, applicable

codes comprise a classification codes used for classifying said provisions provided in

said document (Fig. 1, Table 1, col. 4, lines 12-20).

Response to Arguments

10.   Applicant arguments with respect to claims 16-17 and 30-31 have been

considered but they are not persuasive and details as follows:

     a)   Applicant argument regarding 35 U.S.C. 101 stated as "Applicant

     respectfully requests that the examiner with draw these 35 U.S.C. 101

     rejections."

        In response to Applicants argument, Examiner respectfully agrees.

     Because Applicant amended claims 16 and 30 overcomes the rejection.

     Therefore, the rejection is withdrawn.

     b)   Applicant argument regarding 35 U.S.C. 101 objection stated as

     "Applicant respectfully requests that the examiner withdraws this claim

     objection."

        In response to Applicants argument, Examiner respectfully agrees.

     Because Applicant amended claims 16 and 30 overcomes the objection.

     Therefore, the objection is withdrawn.

c)   Applicant argument regarding 35 U.S.C. 112, 2nd paragraph rejection

stated as "Applicant respectfully requests that the examiner withdraws this 35

U.S.C. 112 rejection."

        In response to Applicants argument, Examiner respectfully agrees.

However, Applicant amended claims 16 and 30 did introduced a new kind of

error because of using the phrase "to be." Therefore, 35 U.S.C. 112, 2nd

paragraph rejection is maintained with a different kind.

d)   Applicant argument regarding rejection of claims under 35 U.S.C. 103

stated as "Zambo fails to teach or suggest, identifying applicable provisions in

codes."

        In response to Applicants argument, Examiner respectfully disagrees,

because Zambo teaches the claimed see at Table 2, col. 6, lines 65-67.

e)   Applicant argument regarding rejection of claims under 35 U.S.C. 103

stated as "Zambo fails to teach or suggest condition codes "CC" consisting

Applicant's claimed., 'comprising natural language text of one of laws, …" (see

Remarks section, page 11, paragraph [0015]).

        In response to Applicants argument, Examiner respectfully disagrees,

because it has been clearly stated as AAPA teaches at (page 1, paragraph

[0002]).

f)   Applicant argument regarding claims 16 and 30 rejection using the prior

art stated as "How the different types of rules of Bigus are related to any Zambo's

condition codes (see Remarks section, page 11, paragraph two from the bottom).

In response to Applicants argument, Examiner respectfully disagrees, because Bigus teaches the claimed limitation of Applicant and there is no need to map to primary reference invention. When both references teach the same concept and details, then there is no need of combining two references. In this case, primary and the second references did not teach the target rules including fuzzy rules and etc. Whereas Bigus do teach those rules at (col. 4, line 64 to col. 5, line 2; col. 4, lines 30-33 and col. 5, lines 15-26).

Conclusion

11.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sathyanarayan Pannala/
Primary Examiner, Art Unit 2164

srp
April 27, 2009